



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,309	04/07/2004	Tapan Chandra	132527-1	7448
23413	7590	04/21/2008	EXAMINER	
CANTOR COLBURN, LLP			RONESL VICKERY M	
20 Church Street			ART UNIT	
22nd Floor			PAPER NUMBER	
Hartford, CT 06103			1796	
			MAIL DATE	DELIVERY MODE
			04/21/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,309

Applicant(s)

CHANDRA ET AL.

Examiner

VICKEY RONESI

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-17 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
2. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

Claim Rejections - 35 USC § 103

3. Claims 1, 3-4, 6-8, 11-16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishio et al (US 5,112,907) in view of Silvi et al (US 5,843,340, cited on IDS dated 7/22/2004).

The rejection is adequately set forth in paragraph 6 of Office action mailed on 7/12/2007 and is incorporated here by reference.

4. Claims 5, 9, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishio et al (US 5,112,907) in view of Silvi et al (US 5,843,340, cited on IDS dated 7/22/2004) and further in view of Bastiaens et al (US 6,353,050, cited on IDS dated 7/22/2004).

The rejection is adequately set forth in paragraph 7 of Office action mailed on 7/12/2007 and is incorporated here by reference.

Response to Arguments

5. Applicant's arguments filed 2/13/2008 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that the copolymer rubber of Nishio should be considered as the adhesion promoter because it complies with the language of the independent

claims and the specification and (B) that criticality has been established for adhesion promoter in amounts of less than 2.5 wt %.

With respect to argument (A), the copolymer (C) of Nishio et al is an impact modifier (col. 4, lines 44-58). Nishio et al does not teach or suggest that the copolymer (C) is an adhesion promoter. Given that the instant claims comprise an impact modifier (claim 6), it is the examiner's position that is more understandable to recognize the impact modifier of Nishio et al as reading on the impact modifier in the instant claims. Furthermore, the copolymer (C) of Nishio et al cannot read on the presently claimed adhesion promoter because Nishio et al discloses amounts of copolymer (C) of 5-100 parts by weight per 100 parts of the composition which are greater than the presently claimed range of 0.5-2.5 wt %.

With respect to argument (B), the data has been considered, however, it fails to establish criticality for the claimed range of 0.5-2.5 wt % adhesion promoter for two reasons. First, the data only compares 1 wt % to 3 wt % and cannot establish criticality for an upper limit of 2.5 wt %. In other words, it has not been established if 2.5 wt % behaves like the data at 1 wt %. Second, the data is not reasonably commensurate in scope with the scope with claims which is to an adhesion promoter selected from alpha-beta unsaturated carboxylic acid copolymer polymers with pendant epoxy groups, or mixtures thereof given that the exemplified adhesion promoters only include Vancryl 68 (styrene-acrylic acid copolymer), Primacor 5990I (ethylene-acrylic acid copolymer), and ECN (epoxy-cresol-novolac). Case law holds that evidence is insufficient to rebut a *prima facie* case if not commensurate in scope with the claimed invention. *In re Grasselli*, 713 F.2d 731, 741, 218 USPQ 769, 777 (Fed. Cir. 1983). Furthermore, case law holds that evidence of superior properties in one species insufficient to establish the nonobviousness of

a subgenus containing hundreds of compounds. *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978).

Conclusion

6. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4/15/2008
Vickey Ronesi

/V. R./
Examiner, Art Unit 1796

/James J. Seidleck/
Supervisory Patent Examiner, Art Unit 1796